REMARKS

Claims 1-20 are still pending in this application. The Examiner has rejected claims 1-20 under 35 U.S.C. §103 as being unpatentable over *Tushie et al.* (*Tushie*) in view of *Harms*. Claims 1 and 11 have been amended to further clarify the claimed invention.

As a first step, claim 1 specifically requires

> executing a personalization assistant software tool, said software tool including a default member profile having default values for smart card features.

The term "smart card features" has a particular meaning as explained in the specification. "Smart card features" refers to features of a smart card. A "member profile" is a profile of a particular member that has default values for the smart card features. The cited portions of *Tushie* do not disclose "a smart card personalization software tool including a default member profile having default values for smart card features." The Office Action apparently relies upon issuer format template data and the card framework template record as disclosing this step.

For example, column 2 of *Tushie* discloses issuer format template data. Column 17 makes clear that a data format template is used to translate data fields into an internal order. An example data format template record is shown in column 17 at line 30. As shown (and as explained later in that same column), the template record simply holds an internal label to show how to order cardholder data internally. It is not a profile of a particular member. It does not have default values for smart card features. It simply holds ordering information to rearrange cardholder data. Further, claim 1 specifically requires in a fifth step that the default member profile is modified based upon user input. The data format template record as shown in column 18 is never modified based upon user input. It has static values. If the Office Action assumes that the data format template record is a member profile, then there is a problem with that analogy because the fifth step of claim 1 requires that the default member profile is modified.

The same problem surfaces with an attempt to equate the card framework template record of column 18 with the default member profile of claim 1. The card framework template record describes the structure of the chip on the card and is referenced at various times during the smart card issuing process (column 18, first full paragraph). Claim 1 requires in a fifth step that this default member profile is modified based upon user responses to queries. There is no disclosure in *Tushie* that the card framework template record is ever modified based upon responses to user queries.

Therefore, it is respectfully submitted that this first step of claim 1 is not taught or suggested by *Tushie* as alleged in the Office action.

Claim 1 requires as a second step

> providing a user with a plurality of queries regarding said smart card features, said queries originating from said software tool.

The Office action alleges that *Tushie* discloses this step in column 6.

Column 6 of *Tushie* at lines 42-56 discloses that the card issuer management system 150 sends cardholder data to the smart card personalization system 100. The management system 150 also determines the type of card issue, the card applications to embed and which personalization equipment to use. But, in the first place, neither the management system nor the personalization system is providing a user with queries regarding smart card features. There is no disclosure in *Tushie* showing that a user is presented with a number of queries and is then given a choice to respond to those queries. The management system of *Tushie* is simply using the prior art that is described in the background of the instant application. In other words, a user using the management system must manually decide on various options and then program software. Claim 1 provides an automatic method of choosing smart card features in order to personalize a batch of smart cards.

In the second place, once the management system tells the personalization system which card to issue, which card application to embed and which personalization equipment to use, there is no opportunity for a user to change those settings. Claim 1 specifically requires that in a third step a user provides responses to queries, and in a fourth and fifth step those responses are matched with data values and the member profile is modified. Once the management system determines which card type to issue (for example) there is no opportunity for a user of the personalization system to change that particular option. By contrast, claim 1 specifically requires that the default member profile is modified using information originating from user responses to queries regarding smart card features.

Therefore, it is respectfully submitted that this second step of claim 1 is not taught or suggested by *Tushie* as alleged in the Office action.

Claim 1 requires as a third step

receiving from the user responses to the plurality of queries, said responses being received by said software tool.

The Office action alleges that *Tushie* discloses this step at 152, and at columns 6 and 7. But, numeral 152 is simply a database of cardholder data. This is static information that does not change (such as cardholder name and cardholder account number); a user is not responding to queries. Also cited is column 6 at lines 53-56. *Tushie* discloses that the personalization system can also receive data from a person inputting the data from a telephone keypad. In other words, cardholder data can be received via a telephone keypad. But, there is no disclosure that this person is responding to a plurality of queries concerning smart card features. In fact, the person is simply inputting static cardholder data that would not change. Claim 1 specifically requires that the responses to these queries are used in a fifth step to modify a member profile. Any cardholder data received does not change and is not used to modify other data in the system.

Also cited is column 7, lines 48-51. This portion also discloses that there are various ways of inputting cardholder data into the card issuer management system such as by a magnetic tape, floppy disk, telephone, *et cetera*. But, there is no disclosure that a user is inputting responses to a plurality of queries regarding smart card features. Someone might be inputting cardholder data, but cardholder data is not a response to a query regarding a smart card feature.

Therefore, it is respectfully submitted that this third step of claim 1 is not taught or suggested by *Tushie* as alleged in the Office Action.

Claim 1 requires as a fifth step

modifying said default member profile using said matched output data values.

As discussed above, *Tushie* does not disclose modifying a member profile using matched output data values that are derived from user responses to queries regarding smart card features. As discussed above, *Tushie* cannot disclose the default member profile because claim 1 specifically requires that it be changed in the above a fifth step. Such a change of a default member profile is not disclosed in either *Tushie* or the *Harms* reference discussed below.

Therefore, it is respectfully submitted that this fifth step of claim 1 is not taught or suggested by *Tushie* as alleged in the Office Action.

Claim 1 requires as a sixth step

generating a personalization data file from said default member profile and said output data values.

Harms describes a system to capture a consumer's name and other information through a drivers license or a government card in the form of a smart card, at a point of sale. The system includes a register, a bar code reader and an ID terminal. The invention is a way to capture information stored on the card using the ID terminal. The terminal can provide user prompts to the operator and can perform data capture, storage, receipt generation, data transmission, and the like. The ID terminal may be similar to the card reader. These devices may all be integrated into one device. The system described is one in which a consumer wanting to participate in a loyalty program with a retailer provides a license or other government ID card which is swiped to log the identity of the consumer at the ID terminal location. The clerk can also key in additional information on the consumer, the transaction, consumer's opinions, or other desired information as prompted on the ID terminal. The ID information captured by the terminal can be represented as an ID data record, such as shown in FIG. 2(A), including name, data of birth, etc.

Purchase information is stored in a purchase data record. The central processing system processes a marketing record (a combination of ID data record and the purchase data record or visit information) by looking for a consumer ID number by searching a consumer database. If one is found, then the consumer has already been added to the database, so the record only needs to be added to the right section of the consumer record in the consumer database. In this manner, the consumer record is updated. If the consumer is not already in the database, an initial record is created.

The Office Action references lines 17-24 of column 5 in *Harms* as teaching the step of providing a user with multiple queries about smart card features, the queries originating from a software tool. It equates the software tool recited in the claims (described as "personalization assistant tool 320") with the ID terminal described above in *Harms* in which a clerk keys in additional information into the ID terminal, like transaction data, consumer opinions, etc. This ID terminal and the keying in of information is not the same as entering queries regarding smart card features into the smart card personalization tool of the present invention.

The Office Action also equates the step of the software tool receiving responses to the smart card queries from the user with the ID terminal where consumer information is gathered

from an ID card, such as a license. However, as explained above, receiving responses to queries regarding smart card features is not anticipated by capturing data from an ID card.

The step of matching a response to a smart card feature query with output data value in a data preparation table of values as described in the specification is equated with a central processing system for checking if the consumer has a record in the consumer database (i.e., to see if the consumer has previously registered with the system). The step of matching a response to queries about smart card features with output data is not anticipated by a system that checks to see if a consumer has a record in a consumer database.

The step of generating a personalization data file, as described in FIGS. 4 and 16 of the present invention, from a default member profile and output data values is equated with creating a consumer data record in *Harms* if one has not been created (i.e., consumer is not in the consumer database). A consumer record is created by accessing data from a government information database, which is inserted into an ID portion of the consumer's record.

The *Harms* reference mentions smart cards once at column 5, lines 44 to 47:

"For example, driver's licenses and the like may ultimately be replaced by so-called smart cards or the like. These cards are essentially small computers that are capable of storing and processing significant amounts of information."

Consequently, Applicant believes that the Examiner's statement that "both of the references (Tushi **and** Harms) teach features that are directed to analogous art and they are directed to the same field of endeavor, such as, databases management systems, **smart cards, and smart card input information**." and that "[t]his close relationship between both references highly suggests an expectation of success" is not entirely accurate. *Harms* mentions smart cards once and only as an another form of a government ID card, whereas the presently claimed invention recites smart cards and smart card features at a level of detail not shown or taught by either of the cited references.

Claim 11 requires many of the same similar steps as claim 1 and is believed patentable for the same reasons.

Reconsideration of this application and issuance of a Notice of Allowance at an early date are respectfully requested. If the Examiner believes a telephone conference would in any way expedite prosecution, please do not hesitate to telephone the undersigned at (612) 252-3335.

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